

U.S. Patent Application No.: 10/518,967
Filing Date: December 21, 2004
First Named Inventor: BOLER, Lewyn B., Jr.

Amendments to the Drawings

Please replace drawing sheet 1 with the attached replacement sheets.

REMARKS

Claims 1-42 are pending in the present application. Claims 1-42 are rejected.
Claims 1-35 and 37-40 are objected to.

Rejection under 35 U.S.C. §112, 1st Paragraph

Claims 1-42 are rejected under 35 U.S.C. §112, 1st Paragraph on the ground that the disclosure of the application is not enabling; the rejection asserts that structural cooperative elements are critical or essential to the practice of the invention but are not enabling. Applicant has made several amendments to address this rejection by clarifying the claims and specification.

First, applicant has amended claims 1 and 18, along with the specification at the second paragraph of the section “Modes for Carrying Out the Invention,” to clarify that the silicone fluid and the surface coating are “mixed into the matrix” of the composite. The relationship between the plastic, the silicone fluid, and the surface coating in the composite are clear at least from instructions for making an embodiment of the composite, as found in the last paragraph of page 13 of the specification as filed. (“One embodiment of the composite of the invention can be prepared by mixing the following (“parts” being defined as parts by mass): (a) about 4 parts of any combination of waxes and silicone resins; (b) about 36 parts of any combination of silicone fluids; (c) about 32 parts polybutene; (d) about 3 parts polyterpene; and (e) about 3 parts polyethylene plastic. After these components have been blended, the mixture may be added to about 100 parts of any combination of inert particles, but preferably to about one part silica sand combined with about 99 parts aluminum silicate. The total weight of the finished composition is about 178.25 parts.”) Hence these clarifying amendments do not add new matter.

Second, while applicant has used terms that may be similar to one another, applicant’s references to (a) a “surface coating” that is component of the composite for coating the subject surface, versus (b) a coating that is placed on the subject surface, versus (c) a layer of silicone that may form on the surface of the composite, are enabling throughout this disclosure.

Nevertheless, applicant has noted the Examiner's points of uncertainty and has amended the disclosure to clarify these points and obviate the rejection by editing the disclosure for additional clarity—using the phrases “subject surface” (the surface being coated), the “surface coating” (the component of the composite that allows the user to coat the subject surface), the “protective coating on the subject surface,” and the “surface of the composite.” In addition, applicant has clarified claims 9 and 10 by editing the references to the layer of silicone fluid on the surface of the composite.

Applicant's amendments clarify the uncertainties pointed out by the Examiner. The Examiner found it unclear whether the composite according to the invention was a laminate or impregnated material or simply a composition. Applicant's usage of the term “composite” refers to a material having multiple components, at least some of which remain distinct following mixture of the material. For example, the inert particles according to the invention remain distinct from the other components and may be suspended in a layer of silicone fluid that may form on the surface of the composite. Second, applicant has amended to clarify which references refer to coatings for surfaces and which refer to the layer of silicone that may form on the composite. Thirdly, the specification, in setting forth the manner of making the invention, clarifies that the silicone fluid is mixed into the composite matrix along with the plastic that forms the majority of the matrix; the composite is elsewhere described as having a layer of silicone fluid formed on the surface of the composite. Both descriptions are accurate because the silicone fluid is found throughout the matrix—in one embodiment, the silicone fluid makes up nearly half of the weight of the composite (about 36 parts of 78 parts by mass) before the inert particles are added. (“One embodiment of the composite of the invention can be prepared by mixing the following (“parts” being defined as parts by mass): (a) about 4 parts of any combination of waxes and silicone resins; (b) about 36 parts of any combination of silicone fluids; (c) about 32 parts polybutene; (d) about 3 parts polyterpene; and (e) about 3 parts polyethylene plastic. After these components have been blended, the mixture may be added to about 100 parts of any combination of inert particles, but preferably to about one part silica sand combined with about 99 parts aluminum silicate. The total weight of the finished composition is

about 178.25 parts.”) Because the amendments further clarify what was already stated in the specification, the amendments add no new matter.

Finally, applicant has amended claim 41 so that claims 41-42 include silicone fluid and wax as required. The amendments do not add new matter because the proportions set out in claims 41 and 42 are described in the specification.

Having addressed the grounds of the rejection, applicant requests that the rejection be withdrawn.

Rejection under 35 U.S.C. §112, 2nd Paragraph

Claims 1-42 were rejected as being incomplete for reasons stated by the Examiner for the rejection under 35 U.S.C. §112, 1st Paragraph. For the reasons stated above, applicant requests that the rejection for incompleteness be withdrawn. As to claims 12 and 28, applicant has amended both claims to provide the necessary antecedent basis by referring to at least one silicone fluid. The amendment does not add new matter. Therefore, applicant requests that this rejection also be withdrawn.

Rejection under 35 U.S.C. §101/112, 2nd Paragraph

The Examiner rejected claim 34 as an improper process claim for failure to state the steps for using the system of claim 17. Applicant previously amended the previous erroneous reference to claim 17 to a reference to claim 18. In addition, applicant has amended claim 34 to state the claimed steps for using the system of claim 18. In light of the amendment, Claim 34 is a proper process claim. Applicant therefore requests that the rejection be withdrawn.

Objection to Drawings

FIG. 1 has been amended to include reference sign **10**, as mentioned in the description. The drawings are now believed to be compliant with 37 C.F.R. §1.84. Applicant requests that the rejection be withdrawn.

Claim Objections

Applicant has amended claims 1 and 18 to correct informalities indicated by the Examiner. Applicant has also amended claims 4, 5, 8, 16, 17, 21, 32, and 40 to address informalities indicated by the Examiner.

Applicant has adopted the Examiner's suggestions as to claims 8, 21, 40, and 4 (with one extra insertion of the phrase "by weight" for clarity in claim 4). As to claims 5, 16, 17, and 32, applicant has substantially adopted the Examiner's suggestions, with the exception that applicant has used the phrase "optionally contains"—as approved by the Examiner elsewhere—rather than "optionally comprises." Applicant has adopted "optionally contains" because applicant believes that "optionally contains" is the clearer phrase to use to express the invention as claimed. To clarify, when the applicant claims a system "wherein the composite optionally contains less than about 10 percent by weight of emulsifiers," then applicant intends the claim to read upon a system wherein the composite contains either (a) no emulsifiers or (b) at most about 10 percent by weight of emulsifiers. These amendments do not add new matter. Applicant has addressed the informalities indicated by the Examiner. Applicant therefore requests that these objections be withdrawn.

Double Patenting Rejection

Today applicant has filed a terminal disclaimer of any portion of the term of this patent extending beyond the term of U.S. Patent No. 7,094,449, which is commonly owned and has a common inventor with the instant application. The terminal disclaimer is sufficient to overcome the rejection for double patenting.

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Conclusion

Based on the Amendments and Remarks above, Applicant respectfully requests allowance of all pending claims.

Respectfully submitted,
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